

## **REMARKS**

Claims 1-13 and 35-50 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

Applicants would like to thank the Examiner for the interview granted with Applicants' representative on September 19, 2006. During the interview, the cited art and the current amendments to the claims were discussed. In particular, the amendments to Claim 1 were suggested by the Examiner. Further, the following arguments discussing the teachings in the art against a combination of two references were discussed. Also, Applicants' representative believed that an agreement was reached that the Examiner would consider the current amendments to the claims.

## **REMOVAL OF CITED ART AS PRIOR ART**

Graf (U.S. 2003/0153912) was published on August 14, 2003, and can only be prior art to the present application under 35 U.S.C. § 102(e). Applicants submit that the claimed priority of Graf to FR 00/08522 and FR 00/10155 does not provide an earlier date for purposes of prior art under 35 U.S.C. § 102(e), as noted in M.P.E.P. § 2136.03, because the priority dates are not when Graf was filed in the United States. In addition, Graf claims it is a continuation of PCT/FR01/02098, filed on June 29, 2001, which is not prior to November 29, 2000, thus the current version of 35 U.S.C. § 102(e) is to be applied. See M.P.E.P. § 706.02(a). Submitted in an IDS filed concurrently with this Amendment is the publication WO 02/00124, which is the publication of PCT/FR01/02098. The publication WO 02/00124 appears to be in a language other than English. Thus, the

date that Graf is prior art is the date of filing in the United States, which is December 27, 2002.

Applicants submitted with the Amendment filed April 3, 2006 a declaration under 37 C.F.R. § 1.131, which was accepted by the Office, showing conception and or reduction to practice of the currently claimed invention prior to January 3, 2002. Because of this, Graf should not be prior art because its filing date is December 27, 2002.

**REJECTION UNDER 35 U.S.C. § 102 AND § 103**

Claims 35-44 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Germany (DE 9312150, hereinafter the “German reference”). Claims 1-13 and 35-50 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Graf (U.S. 2003/0153912). Claims 1-13 and 35-50 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Noiles (U.S. Pat. No. 4,978,356) in view of Germany (DE 9312150). These rejections are respectfully traversed and Applicants respectfully request that these rejections be withdrawn.

As discussed with the Examiner in the interview, independent Claims 1, 45, and 48 have been amended to more clearly direct these claims to a joint replacement prosthesis. As noted above, Graf is not proper prior art to the subject application. Nevertheless, Applicants further submit that Graf is directed to an intervertebral connecting device and not directed to the subject matter of the presently pending Claims 1, 45, and 48. The device of Graf includes a pedicle screw that has a head captured in a mobile element 10 that has an intermediate element 22 and a body 12. The body 12 can span several vertebrae while the screw is fixed into a single vertebra.

Graf does not describe or fairly suggest a prosthesis for replacing a joint, and particularly does not describe or fairly suggest any portion that is sized to replace a portion of an acetabulum or a femoral head. Thus, independent Claims 1, 45, and 48 are in condition for allowance, as are each of the claims that depend directly or indirectly from Claims 1, 45, and 48.

Applicants also submit that many of the defendant claims include patentable subject matter separate from the independent claims. For example, Claim 2 is directed to a cup and a stem operable to be implanted into boney structures. As discussed above, Graf does not teach a cup or a stem and only teaches one portion, a screw, that can be implanted into a boney portion. Thus, Applicants submit that Claim 2 includes patentable subject matter.

Claims 35 and 39 have been amended to include recitations of various axes. Claim 35 has been amended and is directed to a second prosthesis member defining a bore about a first axis having a selected diameter and defining at least one cylindrical portion having a central axis the same as the first axis about at least a portion of a selected equator of said second prosthesis member. Claim 39 has been amended and is directed to a second prosthesis member defining a bore about a first axis having a first diameter substantially equal to said internal concave diameter and defining at least a portion of an equator having a second diameter about the first axis less than said first diameter. The German reference appears to illustrate a ball portion with a part-circular ground surface that is defined, at least in part, by a chamfer 16, 43 of a ball portion, where the chamfer is also a collar or edge of the ball, and any bore defined by the ball is not coaxial with the part-circular ground surface. Thus, the German reference does not

disclose or fairly suggest an axis that defines both the center or a bore and a cylindrical portion or an equator having a second diameter. Thus, Claims 35 and 39 are in condition for allowance, as are each of the claims that depend directly or indirectly therefrom.

The German reference is directed to an assembly that includes a cup portion 2 and a ball portion 14. The ball portion 14 can include a part-circular ground surface 18. Although applicants do not currently possess a certified translation of the German reference, a machine translation performed by Altavista ® BabelFish machine translation service is attached under Tab A. Page 1, lines 3-7 (English translation of the German reference) indicates that a locking collar to restrain Luxation is both complicated and requires an additional part. Applicants submit that Noiles fails to describe a prosthesis that includes a cylindrical equator, but does illustrate a multi-piece prosthesis that includes a metal reinforcing band 120 at the rim 118 to increase the bearings ability to withstand dislocation forces. *See Noiles, column 14, lines 59-63.* Applicants submit that the German reference teaches away from the use of a reinforcing band as disclosed in Noiles and from a combination of Noiles with the German reference. In other words, the German reference notes the disadvantages of a device with a locking ring which, Applicants submit, is similar to the reinforcing band as described in Noiles.

In addition, independent Claims 1, 45, and 48 recite a constraining ring or constraining ring member. As noted above, the German reference teaches away from the use of a locking ring, which Applicants submit is similar to a constraining ring or member. Thus, the combination of the German reference and Noiles would not be

proper to teach each of the presently recited elements, as the German reference teaches away from at least one element recited in these claims.

Applicants submit that each of Claims 1, 45, and 48 is in condition for allowance in light of the cited art. There is no motivation to combine, and the German reference actually teaches away from the combination, with Noiles. As discussed above, the German reference notes relative disadvantages of the device described in Noiles. Therefore, the combination of the German reference and Noiles would not be suggested to one skilled in the art and would not teach or fairly suggest each of the elements in the presently pending claims.

#### CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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